

Remarks

Reconsideration is requested.

Claims 1, 3, 5-7, 10, 12 and 14-16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,327,047 to Motamed in view of U.S. Patent No. 5,214,518 to Kato.

Claim 1 recites a scanner comprising a transparent scanning window; a housing, the housing including an inside, an outside, a first side supporting the scanning window, having an inside surface and having an outside surface, and a second side having an inside surface opposite the inside surface of the first side and having an outside surface; a scanning array movable in the housing relative to the scanning window along a scanning path, the scanning array generally facing the inside surface of the first side; a light source movable with the scanning array, the light source generally facing the first side; and a calibration target supported inside the housing within the scanning path, on the inside surface of the first side and spaced apart from the scanning window, the calibration target generally facing the inside surface of the second side, in operation.

Motamed fails to teach or suggest a calibration target on the inside surface of the first side and spaced apart from the scanning window, in combination with the other features of Applicant's claim 1. Motamed instead discloses that a user attaches a target to an inside surface of a scanner glass, an outside surface of a scanner glass, or to an inside of a scanner cover (col. 3, lines 1-3). An advantage of the design of Applicant's claim 1 is that a user does not have to understand or be concerned with the concept of calibration, and would not even see a calibration target. A user would not need to be concerned with where exactly to place a target or with taking apart the scanner to be able to put a target on an inside surface of a scanner glass.

Motamed does not teach or suggest a calibration target spaced apart from the scanning window. Because Motamed discloses having a user attach a target, the scanner is probably not designed to scan outside the normal scanning window area. Therefore, it would not be obvious to modify Motamed so as to

place targets in locations spaced apart from the scanning window.

It would not be obvious to combine Kato with Motamed because there is no teaching in the prior art which would suggest their combination.

It would not be obvious to substitute a portion of the structure of Kato for portions of the structure of Motamed because there is no teaching in the references of how the components should be combined or of which components of Kato should be combined with which components of Motamed. There are no teachings in the references themselves which teach that there would be any advantage resulting from selecting portions of the structure of Kato and integrating that structure somehow into the structure of Motamed. The mere fact that the structures of the references could possibly be somehow modified to result in the claimed structure does not render the claimed structure obvious unless the references themselves suggest the desirability of the modification. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Evidence of a suggestion to combine may flow from the prior art references themselves, from the knowledge of one skilled in the art, or from the nature of the problem to be solved. However, this range of sources does not diminish the requirement for actual evidence. Further, the showing must be clear and particular. See *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999).

In this case, there is no such evidence of a suggestion to combine the references in the prior art itself. Every embodiment of Motamed contemplates that a target strip be scanned through the scanner glass. See, for example, Col. 4, lines 15-21, Col. 5, lines 13-44, Col. 6, lines 23-46, Col. 7, lines 37-42

Further, modifying Motamed in the manner suggested by the Examiner would defeat an essential purpose of Motamed. More particularly, Motamed discloses, for example, in Col. 3 that an alternative embodiment is provided that comprises automatically calibrating a printer using a scanner. A print of a special printer calibration target is actuated on the printer and a message is generated to ensure that the special printer calibration target is placed on the scanner. If the scanner expects a calibration target to be supported on the inside surface of the first side of the housing and spaced apart from the

window, it would not be able to scan a calibration target that has been printed by a printer.

Therefore, claim 1 is allowable.

As claims 3-9 depend on claim 1, they too are allowable.

Claim 10 recites a method of manufacturing a scanner, the method comprising providing a scanner including a transparent scanning window; a housing, the housing including an inside, an outside, a first side supporting the scanning window, having an inside surface and having an outside surface, and a second side having an inside surface opposite the first side and having an outside surface; a scanning array movable in the housing relative to the scanning window along a path, the scanning array facing the inside surface of the first side; and a light source movable with the scanning array and facing the first side in operation; and permanently providing a calibration target inside the housing, on the inside surface of the first side, within the scanning path, the calibration target facing the second side, prior to delivery to an end user.

Motamed fails to teach or suggest permanently providing a calibration target inside the housing, on the inside surface of the first side, prior to delivery to an end user, in combination with the other limitations of claim 10. Instead, Motamed discloses that a user attaches the target. Motamed also discloses use of weak adhesives or static attraction that can be peeled off by a user (Col. 5, lines 12-23).

It would not be obvious to combine Kato with Motamed for the reasons provided above with respect to claim 1. It would not be obvious to substitute a portion of the structure of Kato for portions of the structure of Motamed because there is no teaching in the references of how the components should be combined or of which components of Kato should be combined with which components of Motamed. There are no teachings in the references themselves which teach that there would be any advantage resulting from selecting portions of the structure of Kato and integrating that structure somehow into the structure of Motamed. The mere fact that the structures of the references could possibly be somehow modified to result in the claimed structure does not render the claimed structure obvious unless the references themselves suggest the

desirability of the modification.

The primary problem addressed by Kato is differences among signal levels detected by individual pixels. If Kato were to be combined with Motamed, the most likely combination would be to change Motamed to correct image data from each pixel. The location of the density indicating segments of Kato is not disclosed as being particularly important or critical. Motamed would have not made any changes in this regard. Doing so would destroy the embodiment of Col. 4, lines 22-39 of Motamed.

Therefore, the combination of references is improper and claim 10 is allowable.

As claims 12-18 depend on claim 10, they too are allowable.

Claim 19 recites a multifunction device comprising a housing having a first side and a second side opposite the first side; a monochrome printer supported in the housing; and a color flatbed scanner supported in the housing, the scanner including, a sub-housing having an inside, an outside, a top side having an inside surface and an outside surface, and a bottom side opposite the top side and having an inside surface and an outside surface, the scanner including a transparent window, supported by the top side of the sub-housing, a scanning array movable in the sub-housing relative to the window along a scanning path, the scanning array generally facing the inside surface of the top side so as to be able to scan the window, first, second, and third color calibration targets supported inside the housing, attached to the inside surface of the top side, spaced apart from the window, within the scanning path, the calibration targets facing the inside surface of the bottom side, a motor configured to move the scanning array along the scanning path, a power switch, coupled to the scanning array and the motor, for turning the scanner on and off, and logic circuitry coupled to the power switch, the scanning array, and the motor, and configured to effect movement of the scanning array to scan the calibration targets in response to the scanner being turned on.

Motamed fails to teach or suggest calibration targets supported inside the housing, attached to the inside surface of the top side, spaced apart from the window, in combination with the other limitations of claim 19.

It would not be obvious to combine Kato with Motomed for the reasons provided above.

Therefore, claim 19 is allowable.


As claim 20 depends on claim 19, it too is allowable.

In view of the foregoing, allowance of claims 1, 3-10, and 12-20 is requested.

The Examiner is requested to phone the undersigned in the event that the next Action is one other than a Notice of Allowance. The undersigned is available for telephone consultation at any time.

Respectfully submitted,

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By: 
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